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09/671,424

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Michael L. Grandcolas

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02/10/2009

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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL L. GRANDCOLAS,
NANCY BRYANT, HOWARD A. SCHECHTMAN
and
DILIP J. PAREKH

Application 09/671,424
Technology Center 3600

Mailed: February 10, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal*.

BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on September 22, 2008. A review of the Image File Wrapper (IFW) revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF, GROUNDS OF REJECTION

A review of the file finds that the grounds of rejection of the claims as provided in the Appeal Brief filed June 13, 2007 under the heading “Grounds of Rejection to be Reviewed on Appeal” is unclear and/or is not consistent with the grounds of rejection of the claims of record. The grounds of rejection of the claims as provided in the Appeal Brief must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each grounds of rejection to be reviewed on appeal must be identified.

A review of the last Office action, including any mailed Advisory Action(s), finds that the Non-Final Rejection mailed June 1, 2007 lists the grounds of rejection as follows:

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,539,361) Richards et al, hereafter Richards [page 3]; and

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,539,361) Richards et al, hereafter Richards in view of (US 6,061,666) Do et al, hereafter Do [page 6].

However, the Appeal Brief filed June 13, 2007 lists the sole ground of rejection as follows:

Claims 51 and 52 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Richards (U.S. 6,539,361) [page 4].

Correction of the grounds of rejection to be reviewed on appeal is required.

APPEAL BRIEF, CLAIMS APPENDIX

A review of the Appeal Brief filed June 13, 2007 also reveals that claims 51 and 52 appearing in the Claims Appendix of the Appeal Brief are not consistent with the last entered Amendment filed on April 26, 2007. According to § 706.07(e) of the *Manual of Patent Examining Procedure* (MPEP), Eighth Edition, Rev. 5, August 2006:

When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered.

Hence, the April 26, 2007 Amendment was entered. Please see the “Detailed Action” section appearing on page 2 of the Non-Final Rejection mailed June 1, 2007. Correction of claims 51 and 52 is required.

CONCLUSION

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on June 13, 2007 defective;
- 2) to notify Appellants to file an amended Appeal Brief which corrects the “Grounds of Rejection to be Reviewed on Appeal,” “Claims Appendix” and any other section as may be required;
- 3) to acknowledge and consider the amended Appeal Brief; and
- 4) for such further action as may be required.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

Application 09/671,424

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